



WIPO Arbitration and Mediation Center

ENTSCHEIDUNG DES BESCHWERDEPANELS

1. The Parties

The Complainant is Le Creuset ..., ..., United Kingdom represented by

The Respondent is Vineyards ... , of ..., United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <lecreusetdirect.com> (the "Domain Name") is registered with Tucows, Inc, of Ontario, Canada.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 26, 2004. On July 26, 2004, the Center transmitted by email to Tucows, Inc a request for registrar verification in connection with the Domain Name. On July 26, 2004 Tucows, Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 29, 2004. In accordance with the Rules, paragraph 5(a), the due date for Response was August 18, 2004. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 19, 2004.

The Center appointed Steven A. Maier as the Sole Panelist in this matter on August 24, 2004. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

Having reviewed the communications in the light of the Respondent's default, the Panel is satisfied that the Center has discharged its responsibility under paragraph 2 of the Rules to notify the Respondent of this Complaint. Under paragraph 14(a) of the Rules, where a party fails to comply with the time limits provided by the Rules, the Panel shall proceed to a decision on the Complaint in the absence of exceptional circumstances. The Panel is aware of no such circumstances in this case.

4. Factual Background

The Complainant is a private company registered in France. The Respondent is a private company registered in England and Wales. The Respondent registered the Domain Name on January 19, 2004.

5. Parties' Contentions

A. Complainant

The Complainant submits that it is a French company in the business of manufacturing and distributing cookware equipment. It was established in 1925 and has grown into an internationally recognized brand. It enjoys a reputation with chefs, restaurateurs and consumers as the world's leading manufacturer of enameled cast iron cookware. It has ten subsidiary companies worldwide. Its products are available from cookshops, department stores and its own retail stores in the US and in Europe. Its total turnover in 2003 was 112 million euros.

The Complainant states that it has sold products internationally under the LE CREUSET brand for many years. It has been active on the Internet for several years and has operated a website at www.lecreuset.com since 1997. It operates a total of seven websites dedicated to the US, Brazil, the UK, Scandinavia, France and Germany. In addition, at its site at www.lecreusetexport.com it offers information on where to buy its products in over 70 other countries. The Complainant relies heavily on its websites to promote its brand and in 2003 received hundreds of thousands of visitors and several million hits to those sites.

The Complainant submits that in the light of the quality of its goods and services, the number of its customers and its promotional activities on the Internet and elsewhere, the LE CREUSET mark is famous, has acquired substantial goodwill belonging to the Complainant and is an indication of origin exclusively identified with the Complainant.

The Complainant also refers to an extensive portfolio of registered trademarks in the sign LE CREUSET, including word and device marks, particulars of which are exhibited to the Complaint. These include numerous registrations in Class 21 and other classes in a wide variety of territories throughout the world.

The Complainant sets out the chronology of events leading to its Complaint. It became aware of the Respondent's website at www.lecreusetdirect.com in April 2004 and submits:

It was immediately apparent upon entering the website that the Respondent had designed the layout and content of the website so as to resemble an official Le Creuset website.

A printout of the Respondent's homepage as at April 20, 2004 is annexed to the Complaint and the Complainant continues:

The Panel will notice, in particular, the use of a 'D' shaped logo (black with an orange centre) which the Complainant submits was a clear attempt to imitate the 'bulls-eye' logo used by Le Creuset.

The Complainant also points to the use by the Respondent of the online trading name 'le creuset direct.com'.

The Complainant refers to, and exhibits, a letter of complaint that its solicitors sent to the Respondent on April 23, 2004. The letter threatens court proceedings for trademark infringement and passing off. It states that although the Respondent is using the mark LE CREUSET to sell goods originating from the Complainant, such use is not in accordance with honest practices in industrial or commercial matters. The letter states:

Your use of a domain name incorporating the Trademark and your adoption of the trading name lecreusetdirect.com deceives members of the public into believing that you have a special trading relationship or connection with our clients.

In addition to the objection to the 'bulls-eye' logo, the Complainant's solicitors refer in the letter to a pop-up notice referring to the Complainant's own website, which they say makes it more, rather than less, likely that Internet users will believe there is a connection between the parties. The notice stated:

IMPORTANT NOTICE ? PLEASE READ

www.lecreusetdirect.com is owned by and is the online trading name for Vineyards Unless purchased from this site, any queries regarding the lifetime guarantee of your Le Creuset cookware products should be made to: www.lecreuset.co.uk or by post to Le Creuset UK Ltd, 4 Stephenson Close, East Portway, Andover, SP10 3RU
Telephone: 0800 37 37 92
Thank you.

The Complainant states that, in response to the letter referred to above, it received a single page fax, presumably from the Respondent although no sender details were visible, showing a redesigned homepage for the Respondent's website and a change of trading name to 'French Cookware direct.com'. Thereafter, the Respondent's website was relocated to www.frenchcookware.com (cited later in the Complaint as www.frenchcookwaredirect.com) and traffic to the former URL was automatically redirected to that site.

The Complainant states that the Respondent failed to provide the undertakings requested in its original solicitors' letter and failed to make any response to a further letter, dated May 19, 2004.

In the circumstances, the Complainant submits, for the purposes of paragraph 4(a)(i) of the Policy, that the Domain Name is confusingly similar to a trademark in which the Complainant has rights. The LE CREUSET mark instantly evokes the Complainant's famous products and the addition of the term 'direct' is of no material effect. The Complainant submits that this is a generic word commonly used to indicate online services and relies on the following WIPO decisions:

Fortnum & Mason PLC v. Corporate Business Sales Limited, WIPO Case No. D2000-1207;

Asprey & Garrard Limited v. Corporate Business Sales Limited, WIPO Case No. D2001-0958;

A. Natterman & Cie Gmbh, Aventis Pharma SA v. Derrick Horner, WIPO Case No. D2003-0844;

Société Air France v. Hosters Direct, WIPO Case No. D2004-0170.

The Complainant further submits, for the purposes of paragraph 4(a)(ii) of the Policy, that the Respondent has no rights or legitimate interests in respect of the Domain Name. By combining the Complainant's mark with a generic word, the Respondent is attempting to create an association with the Complainant by suggesting that its site is that of the Complainant or of an official agent or distributor. This cannot amount to legitimate non-commercial or fair use. Rather, the Respondent is using the Domain Name, with the intent of commercial gain, misleadingly to divert consumers to the Respondent's website.

The Complainant continues:

The Respondent does, from its website, offer for sale goods which appear to originate from the Complainant. However, there is no commercial relationship between the Complainant and the Respondent, which would entitle the Respondent to use the mark LE CREUSET in the manner that it does. The Respondent is not in any way related to the Complainant's business as a licensee, distributor, agent or otherwise.

The Complainant cites the following WIPO decisions in support of this submission:

Nokia Corporation v. Nokia Ringtones & Logos Hotline, WIPO Case No. D2001-1101;

Nokia Corporation v. Nick Holmes t/a EType Media, WIPO Case No. D2002-0001;

Volvo Trademark Holding AB v. e-motordealer Ltd, WIPO Case No. D2002-0036;

Six Continents Hotel, Inc v. Patrick Ory, WIPO Case No. D2003-0098.

Further, the Complainant submits that the Respondent's use of the mark LE CREUSET in the Domain Name constitutes trademark infringement and it can therefore have no legitimate right or interest in the Domain Name. Here the Complainant cites:

The Chase Manhattan Corporation et al. v. John Whitely, WIPO Case No. D2000-0346.

Finally, for the purposes of paragraph 4(a)(iii) of the Policy, the Complainant contends that the Domain Name was registered and is being used in bad faith. It relies specifically upon the submission that:

the Respondent has intentionally attempted to attract for commercial gain, Internet users to its website location by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location of a product or service on the website or location.

The Complainant states that the Respondent deliberately chose the Domain Name to capitalize on the Complainant's goodwill. It further submits that the Respondent having moved its website from www.lecreusetdirect.com to www.frenchcookwaredirect.com, and having changed its trading name accordingly, evidences its knowledge that the use of the Domain Name is misleading.

The Complainant requests a transfer of the Domain Name.

B. Respondent

The Respondent has not filed a response in this matter.

6. Discussion and Findings

In order to succeed in its complaint, the Complainant is required to prove that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

(i) that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) that the Domain Name has been registered and is being used in bad faith.

Before examining these elements in detail, the Panel observes that, although the Respondent has failed to file a Response, it is still for the Complainant to prove its case. Further, while the factual assertions made by the Complainant may be uncontradicted by the Respondent, the Panel must nevertheless examine the circumstances that are apparent from the Complaint itself in arriving at its conclusions.

Identical or Confusingly Similar

It is plain that the Complainant is the owner of extensive registered and unregistered rights in the mark LE CREUSET. The Panel accepts that the mark LE CREUSET forms the dominant part of the Domain Name with the suffix "direct" being descriptive in nature. Accordingly, the Panel finds that Domain Name is confusingly similar to a trademark in which the Complainant has rights.

No Rights or Legitimate Interest

Under paragraph 4(c) of the Policy:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name..."

The circumstances listed include only one that is relevant to this Complaint, namely:

"(i) before any notice to the Respondent of the dispute, its use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services."

In this case, the Complainant acknowledges that the Respondent is using the Domain Name to link to a website that offers goods "that appear to originate from the Complainant." It is also clear that this use of the Domain Name predated any notice of dispute. However, the Complainant contends that the Respondent is nevertheless misusing the Complainant's mark because its use of the Domain Name implies a commercial relationship between the parties and it is not, in fact, a licensee, distributor, agent or similar of the Complainant. The Complainant cites a number of WIPO decisions in support of this proposition.

While the Panel gives due weight to these decisions, they may clearly be distinguished from the present case. In the two *Nokia* cases and the *Volvo* case the respondents were offering goods or services that were not the complainant's, and in the *Six Continents* case the Respondent was offering services emanating from the complainant, but also from other suppliers. In this case, however, there is no contention that the goods offered by the Respondent are not the Complainant's goods, nor is it contended that the Respondent is using the Domain Name to offer goods other than the Complainant's.

Cases involving the resale of the trade mark owner's goods have been considered by a number of WIPO panels and a helpful statement of applicable principles is contained in:

Oki Data Americas, Inc v. ASD, Inc, WIPO Case No. D2001-0903 (domain name <okidataparts.com>). The case set out the following criteria for determining the circumstances in which a respondent's offering of the trademark owner's goods may be characterised as *bona fide*:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site only to sell the trademarked goods (otherwise its activities could be viewed as a "bait and switch" operation);
- (iii) the respondent's site should accurately disclose the respondent's relationship with the trademark owner; it should not falsely suggest that it is that of the trademark owner, or that it is the official site;
- (iv) the respondent must not try to corner the market in domain names pertaining to the trademark.

While the respondent in the *Oki Data* case was an authorised distributor of the complainant's goods, it does not appear to the Panel that this is a precondition of *bona fide* use. Indeed, the *Oki Data* principles were applied in the following recent case, in which the respondent had no contractual connection with the complainant (and indeed offered other manufacturers' products, albeit on different websites):

Dr. Ing. h.c. F. Porsche AG v. Del Frabbo Laurent, WIPO Case No. D2004-0481 (domain names <porsche-buy.com> and <porschebuy.com>).

In the present case, the Panel is of the view that the first and second criteria set out in the *Oki Data* case are satisfied and that the fourth has no application. The third criterion is considered in more detail below.

The Panel observes more generally that, under the principle of exhaustion of rights, the owner of a trademark cannot generally object to the use of that mark in connection with the resale of goods that it itself has placed on the market. The mark may also be used to advertise the goods in question, providing it is not used in a manner, which causes confusion, or damage to the reputation of the mark. These principles are accepted internationally, although their precise formulation varies somewhat in different jurisdictions. The principles have been applied in WIPO decisions including:

Koninklijke Philips Electronics N.V. v. Cun Siang Wang, WIPO Case No. D2000-1778 (domain name <philips-indonesia.com>).

In the present case, given that the Respondent is using the Domain Name to sell the Complainant's goods, and only the Complainant's goods, the Panel finds that there is a *prima facie* case that it has used, and is using, the Domain Name in connection with a *bona fide* offering of goods and services. However, that *prima facie* case can be rebutted if the Complainant can show that the Respondent is using the mark in a manner that causes confusion or that it damages the reputation of the mark, or indeed that the Respondent's conduct offends against any of the specific criteria set out in the *Oki Data* case. In such cases the use would not be *bona fide*.

So far as confusion is concerned, the Complainant relies on two contentions that can be summarised as follows: first, that the Respondent's website, logo and original trading name falsely created the impression of an association between the parties and, secondly, that the Domain Name itself is bound to deceive.

With regard to the Respondent's website and trading style, the Panel does not find the Complainant's case to be persuasive. It is contended that the original appearance of the Respondent's website was intended to resemble the Complainant's official sites, but on examination of the materials exhibited by the Complainant the Panel does not consider this to be established. In addition, the Panel has regard to the fact that the Respondent took steps to change the appearance of its site after receiving a letter of complaint from the Complainant's solicitors: the Complainant makes no specific comment upon the appearance and effect of the Respondent's website following these changes.

Objection is also taken to the use of a 'bulls-eye' logo which resembled the Complainant's own logo (which is also a registered trademark). However, the Panel does not consider this to be a point of particular significance, since the underlying question is whether or not the Respondent is entitled to use the Complainant's trademark to market the Complainant's goods. If so, it is also entitled to use its logo. In any event, the offending logo also appears to have been removed by the Respondent following the Complainant's letter of complaint.

With regard specifically to the third of the *Oki Data* criteria, the Panel does not consider the Respondent to be giving the impression that it is the trade mark owner or that it is operating an official site. The Respondent's own identity is clearly set out on its home page and, in the opinion of the Panel, the original pop up notice (to which the Complainant objected) further contributed to making its independent identity clear. While the Panel believes that the Respondent could have gone further, by expressly stating that it was not connected with the Complainant, the Panel does not believe that there is any misrepresentation in this case sufficient to undermine a finding of *bona fide* use.

Turning to the Domain Name itself, the Panel is sympathetic to the contention that the domain name <lecreusetdirect.com> may be suggestive of a website owned, or at least authorized by, the Complainant. However, in this case, the Complainant has offered no evidence of actual confusion on the part of any Internet user. Therefore, it appears to the Panel that the Complainant can only succeed on this ground if it can show (or if the Panel simply accepts) that the use of the Complainant's trademark with the suffix 'direct' is inevitably suggestive of the Complainant's own, or an authorized, site.

In support of the proposition that this is so, the Complainant relies on a number of WIPO decisions. In connection with the *Fortnum & Mason* case, it submits:

the panel stated that the addition of the word 'direct' to the distinctive and well known trademark of a retailer is an obvious and descriptive means of indicating the Internet-based service of that retailer.

However, no such finding was made by the panel in the *Fortnum & Mason* case and the quotation attributed to the panel is, in fact, taken from the complainant's submissions. In that case, the panel found that the respondent did not appear to have any rights or legitimate interest in the domain name, that the respondent had registered the name to demand unwarranted profit in bad faith from the complainant, and that the respondent had been engaged in a course of such conduct.

The *Asprey & Garrard* case was also decided on the basis that there was no legitimate use by the respondent of the domain name and that the respondent had registered it for the purpose of selling it to the complainant at a profit.

Accordingly, the Panel does not find there to be an established line of authority that the addition of the term 'direct' to a trademark is inevitably suggestive of the trademark owner's own, or an authorized, website. Rather, each case must be considered on its own merits. In this case, the Panel is not of the view that the choice of the Domain Name inevitably gives rise to a likelihood of confusion. The Panel also observes that a case based on the suffix 'direct' may well be stronger where the complainant is primarily a retailer,

as opposed to a case such as the present, where the Complainant is primarily a manufacturer whose goods are sold by retailers, including retailers independent of the Complainant.

The Complainant further contends that, as the use of the Domain Name amounts to trademark infringement, the Respondent can have no legitimate rights or interest in the name. However, in the circumstances outlined above, the Panel is not in a position to make a summary determination that the Respondent's use of the trademark amounts to trademark infringement (indeed, in order to show that the Respondent has *no* legitimate rights or interests in the name, it would be necessary to make such a determination in every relevant jurisdiction). This would be a matter for an appropriate court to decide, where evidence relating to various matters, including the source of the goods being resold and the terms of their original sale, might well need to be considered. It is, of course, open to the Complainant to bring a claim or claims for trademark infringement against the Respondent, as indeed it has threatened to do.

In the circumstances, the Panel finds that the Complainant has failed to prove that the Respondent has no rights or legitimate interests in the Domain Name.

Registration and Use in Bad Faith

The final matter that the Complainant is required to establish is that the Domain Name was registered, and is being used, in bad faith.

Paragraph 4(b) of the Policy, sets out four sets of circumstances that, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Again, only one is relevant to this case:

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Panel does not consider bad faith to be present in this case. As discussed above, the Complainant has not established to the satisfaction of the Panel that the website operated by the Respondent was designed to give the impression that it was an 'official' Le Creuset site. Furthermore, there is no submission that the Complainant offers online sales of its own, with which the Respondent's services are liable to be confused.

It is also relevant to bad faith that the Respondent made changes to its site and trading name in response to a letter of complaint received from the Complainant's solicitors. In particular, it removed the heading 'lecreusetdirect.com' and 'bulls-eye' logo and changed its name to 'FrenchCookwareDirect.com' (with the sub-heading 'We sell Le Creuset cookware direct'). It also redirected Internet traffic from 'www.lecreusetdirect.com' to 'www.frenchcookwaredirect.com'. The Complainant contends that the last of these changes in itself evidences continuing bad faith use on the part of the Respondent. However, the Panel prefers the view that the changes made by the Respondent were intended to be cooperative with the Complainant. In summary, it appears to the Panel that the dominant motive of the Respondent in this case is to sell the Complainant's goods on its own account, not intentionally to confuse Internet users.

As also discussed above, the Panel is not of the view that the use of the suffix 'direct' together with the Complainant's mark is inevitably suggestive of the Complainant own, or an authorized, website. Accordingly, in this case, bad faith is not established on the ground that the Respondent's choice of domain name must inevitably give rise to the likelihood of confusion.

Finally the Panel observes that the Policy was developed primarily as an anti-cybersquatting measure, and although it has application to a wider category of cases, the element of dishonesty is key to both the second and third limbs of the test under paragraph 4(a). This is not a case of cybersquatting and dishonesty has not otherwise been demonstrated. Accordingly, while it is open to the Complainant to test the Respondent's use of its trademark in other fora, the Panel does not consider that the Complainant has succeeded in proving its case within the specific requirements of the Policy.

7. Decision

For the foregoing reasons, the Complainant has failed to establish that the Respondent has no rights or legitimate interests in respect of the Domain Name or that the Domain Name has been registered and is being used in bad faith. Accordingly, the Complaint is denied.

(Sole Panelist)